REMARKS

This paper responds to the Office Action dated August 24, 2009, in which claim 1–4, 6–11, 13, and 15 were pending. In the Office Action, the Examiner rejected claims 1–4, 6–11, 13, and 15 under 35 U.S.C. § 103(a). In response, Applicants have amended claims 1 and 11 in order to more particularly point out and distinctly claim the subject matter which Applicants regard as their invention. No new matter has been added. Support for the claim amendments may be found in the specification at, for example, paragraph [012]. In view of the amendments and the following remarks provided in connection therewith, reconsideration and allowance of all pending claims are respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1–4, 6–11, 13, 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0158777 (Schiff et al.) (hereinafter "Schiff") in view of U.S. Patent No. 7,370,004 (Patel et al.) (hereinafter "Patel"). Applicants traverse these rejections for at least the following reasons.

-Claim 1

Claim 1, as currently amended, recites in part "a marketing system that matches a customer profile to product/service offers . . . comprising: . . . a database comprising a customer profile containing information related to a customer's interests in types of products and services . . . wherein the customer profile comprises a permission-based marketing profile, and the server continuously communicates through an Internet connection to scan for product/service offers that appear to match the customer profile, and provides the customer an offer based on the types of products and services associated with the customer profile comprising the permission-based marketing profile and instant communication with a product/service provider offering the matching product/service . . . ." Applicants respectfully submit that neither Schiff nor Patel, either alone or in combination, disclose, teach, or suggest the marketing system as claimed.

Schiff is directed to a system for messaging over a data network, such as the Internet or interactive TV. The system allows registered customers to generate and update one or more customer portfolios. The portfolios contain information related to providers or individuals from

which the customer has indicated a willingness to receive messages related to products or services. The messages are displayed to the customer through a webpage or web portal. *See* Schiff, *Abstract*.

Claim 1 is patently distinguishable over Schiff at least with respect to the design and operation of the "permission-based marketing profile." Schiff discloses that the customer-created "portfolios" contain information related to the *providers* from which the customer is willing to receive messages. In contrast, Claim 1 provides the customer profile comprises a permission-based marketing profile based on the *types* of products/services of interest to the customer.

A permission-based profile based on the type of content rather than the source of content exhibits several advantages. First, as will be appreciated by those skilled in the art, a single company may offer numerous types of products and services. For example, a department store may sell everything from power tools to perfume. Thus, a profile based on the source of the message may not allow the customer to meaningfully limit the content of the messages received. This is disadvantageous because a customer may receive numerous offers—even from a single company which the customer has specified in their profile—which are not of interest to the customer.

Second, some customers may be unfamiliar with the products or services offered by a company, causing the customer to configure their profile so as not to allow that company's messages to be received. This is disadvantageous because it may result in the customer not receiving desirable messages, simply because the customer was unaware that the excluded (or non-specified) company offered products or services desirable to the customer.

Embodiments of the presently disclosed system in accordance with Claim 1 solve the problems inherent in Schiff. By allowing a customer to specify the types of products and services in which they are interested, rather than the source, the customer is able to avoid receiving messages related to undesirable products and services from a single company which offers numerous types of products and services, *and* the customer is able to receive desirable

messages from a company even if the customer had previously been unfamiliar with the types of products and services offered by that company.

The combination of Patel with Schiff, as suggested by the Examiner, does not remedy the deficiencies inherent in Schiff. Patel is directed to a system for personalizing interaction between a customer and a provider of information, products, or services. The system comprises an information, product, or service interface for interfacing with an information, product, or service provider and a knowledge management system. The knowledge management system comprises a knowledge management repository for storing information concerning the customer. The information may be obtained from previous interactions with the customer and current interactions between the customer and the knowledge management system. The system further comprises a personalization engine for making a decision as to which of the plurality of information, products, or services to present to the customer over a communication channel based on the stored information in the knowledge management repository. *See* Patel, *Abstract.*

First, Applicants respectfully submit that a person skilled in the art would have no motivation to combine Patel with Schiff. While Patel does generally relate to electronic messaging or marketing, its disclosure is confined to the environment of the products or services provided by a single company. That is, Patel provides a method for a company to market additional products or services to existing customers, based on information gathered through the existing customer / business relationship. Schiff, in contrast is designed as a means to provide offers for products or services from multiple companies, irrespective of previously existing customer relationships. Furthermore, while Patel does generally create a customer "profile," the customer has no means to specify the offers for products or services received. Rather, Patel creates a profile based on an existing customer relationship and current customer interactions, without allowing the user any control over the offers which the system identifies as being relevant to the customer. Therefore, because Schiff and Patel differ with respect to several critical aspects—their respective operating environments and the way in which their respective "profiles" are generated—a person skilled in the art would not recognize the teachings of Patel as being combinable with the teachings of Schiff.

Second, even if <u>Patel</u> were properly combinable with <u>Schiff</u>, such combination would not teach, suggest, or disclose the system as recited in Claim 1. As previously discussed, <u>Patel</u> does not even disclose a "permission-based marketing profile" as claimed. In fact, <u>Patel</u> provides the customer with no means to limit or restrict the messages received whatsoever. Therefore, clearly, <u>Patel</u> would not teach or motivate one skilled in the art to modify <u>Schiff</u> so as to overcome the previously discussed disadvantages inherent in <u>Schiff</u> regarding the customer profile.

-<u>Claim 11</u>

Claim 11, as currently amended, includes limitations similar to those in Claim 1 in aspects relevant to the arguments presented above. Therefore, Claim 11 is patentable over <u>Schiff</u> and <u>Patel</u> for at least the same reasons as Claim 1.

-<u>Claims 2–4, 6–10, 13, and 15</u>

Claims 2–4, 6–10, 13, and 15 depend from, and incorporate all the limitations of, either Claim 1 or Claim 11. Thus, for the reasons set forth above, Applicants respectfully submit that claims 2–4, 6–10, 13, and 15 stand in allowable form.

For all of the forgoing reasons, this Application now stands in allowable form. Reconsideration of the rejections and a favorable response are respectfully requested.

CONCLUSION

This response is being submitted on or before November 24, 2009, making this a timely response. It is believed that no additional fees are due in connection with this filing. However, the Commissioner is authorized to charge any additional fees, including extension fees or other relief which may be required, or credit any overpayment and notify us of same, to Deposit Account No. 04-1420.

If a telephone conference would be helpful in resolving any remaining issues, please contact the undersigned at (612) 492-6867.

Respectfully submitted,

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Date: _Nov. 20, 2009_

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